

REMARKS/ARGUMENTS

Favorable reconsideration of the above-identified patent application, in light of the above amendments and the following remarks is respectfully requested. The presently pending claims are claims 1-12. Claims 1, 9, and 12 have been amended.

In paragraphs 1 and 2 of the Office Action, the Examiner rejected claim 12 under 35 U.S.C. 102 (b) as being anticipated by, or in the alternative, under 35. U.S.C. 103(a) as obvious over U.S. Patent No. 4,188,437 to Rohowetz (Rohowetz). The Examiner stated that the phrase “postage stamp” is not given any patentable weight. In addition, the Examiner stated that Rohowetz discloses adhesive tapes that change color in the presence of water or steam at an elevated temperature and are useful as sterilization indicators.

Furthermore, the Examiner stated, that with respect to the rejection of claim 12 under 35 U.S.C. 103(a), Rohowetz teaches that while the tapes are designed primarily as sterilization indicators, they may provide other functions as well. For example, the tape may be printed to incorporate a message such as advertising material. The Examiner also stated that it would have been obvious to one having ordinary level of skill in the art at the time of the intention was made to combine a sterilization color indicator with a postage stamp because Rohowetz teaches that it is known to combine a sterilization color indicator with printed matter on a substrate comprising an adhesive backing.

In response, the Applicant has amended independent claim 1 to better differentiate Applicant’s invention from the cited reference. In regards to the U.S.C. 102(b) rejection, the Examiner stated that a “postage stamp” is not given any patentable weight because the pictures or

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markings on a material are not held to be patentable. The Applicant respectfully disagrees. A postage stamp is much more than printed matter. Rather, a postage stamp is a form of payment to the U.S. Postal Service for delivering a mail article. The stamp provides a specific domination of payment and is, in reality, a type of currency.

Rohowetz discloses adhesive tapes that change color in the *presence of water or steam* to provide an indication of sterilization. On the other hand, Applicant's claimed invention includes a postage stamp which simultaneously provides a dual indication of providing proof of payment to the U.S. Postal Office, as well as an indication that the mail article has been sterilized by a beam of energy. Rohowetz does not disclose utilizing a beam of energy to irradiated a mail article. Additionally, Rohowetz does not disclose affixing a postage stamp to a mail article.

In addition, the Applicant respectfully disagrees that Rohowetz discloses all the elements of the claimed invention. Rohowetz merely discloses an adhesive strip which changes color in the presence of water or steam, which would not be an effective way of sterilizing mail articles. For prior art to anticipate under Section 102, every element of the claimed invention must be identically disclosed, either expressly or under principles of inherency, in a single reference. *Corning Glass Works v. Sumitomo Electric*, 9 U.S. P.Q. 2d 1962, 1965 (Fed. Circ. 1989). The exclusion of a claimed element, no matter how insubstantial or obvious, from a prior art reference is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Circ. 1983). Rohowetz does not disclose *a sterilization process utilizing a beam of energy, or a postage stamp, or a mail article*. In regards to inherency, inherency may be relied upon where, but only where, the consequence of following the reference disclosure always inherently produces or results in the

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claimed invention. *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Circ. 1983). If there is not a reasonable certainty that the claimed subject matter will necessarily result, the rejection fails. *In re Brink*, 164 U.S.P.Q. 247 (CCPA 1970). Also, accidental results, not intended and not appreciated, do not constitute an anticipation. *Georgia-Pacific Corp. v. United States Plywood Corp.*, 118 U.S.P.Q. 122, 128 (2nd Circ. 1958).

In regards to the rejection of claim 12 under 35 U.S.C. 103(a), the Examiner stated it is known to use printed matter in combination with a sterilization color indicator on an adhesive strip. However, a postage stamp is much more than printed matter. A postage stamp is a form of currency utilized by the U.S. Postal Service. Therefore, it would not have been obvious to combine a sterilization color indicator with a postage stamp because Rohowitz does not teach or suggest combining a sterilization indicator with a *postage stamp*. Therefore, the withdrawal of the rejection and the allowance of claim 12 is respectfully requested.

* In paragraphs 3 and 4 of the Office Action, the Examiner rejected claims 1-11 under U.S. C. 103(a) as being unpatentable over Patent Application Publication US 2002/0162971 to Koenck et al. (Koenck) in view of Patent Application Publication US 2003/0072674 to Melker et al. (Melker). The Examiner stated that Koenck discloses a system and method for irradiating and sterilizing mail articles that may be contaminated. The Examiner also stated that although the reference does not specifically disclose the step of affixing a postage stamp to a mail article, it is implied that mail which has been collected by postal workers will have proper postage stamp since posted is required. However, the Examiner further stated that Koenck does not teach a sterilization indicator affixed to the mail articles for indicating that the sterilization process is complete. The Examiner stated that

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Melker discloses an adhesive strip that changes color in response to a sterilization process. The Examiner then stated that it would have been obvious to one of ordinary level of skill in the art at the time the invention was made to modify the invention of Koenck and include an adhesive chemical indicator strip.

In response, the Applicant has amended independent claims 1 and 9 to better differentiate Applicant's invention from the cited references. Claims 2-8 depend from amended independent claim 1 and recite additional limitations in combination with the novel elements of claim 1. Additionally, claims 10 and 11 depend from amended independent claim 9 and recite additional limitations in combination with the novel elements of claim 9.

Koenck discloses a system for irradiating mail. The use of such a system is now quite common in the advent of increased terrorist activities. Melker discloses an adhesive strip that changes color upon a sterilization process based on heat. The Applicant's claimed invention discloses an indicator which is utilized as both a postage stamp and a sterilization indication. The sterilization indicator indicates that a sterilization process has been completed utilizing a beam of radiated energy. Melker does not teach or suggest an indicator which changes based on an irradiation process, but rather teaches an indicator which changes based on temperature changes.

In addition, neither reference teaches utilizing an indicator which performs two specific functions, namely providing a sterilization indication as well as indicating that payment has been paid for the postage. As discussed above, a postage stamp is far more than merely printed matter, but rather is a currency utilized by the U.S. Postal Service.

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In addition, the Applicant respectfully disagrees in that it would be obvious to one of ordinary skill to combine Melker and Koenck. For prior art references to be combined to render obvious a subsequent invention under Section 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q.2d at 1599. Hindsight is strictly forbidden. It is impermissible to use the claims as a framework from which to pick and choose among individual references to recreate the claimed invention. *Id.* At 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Circ. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Neither Melker nor Koenck provide any suggestion or motivation to combine its elements. Koenck is merely a sterilization system which Applicant has acknowledged is utilized in the U.S. Postal Service. Melker provides an adhesive strip providing an indication of sterilization based upon a change in temperature. Melker does not suggest utilizing these adhesive strips as postage stamps. Therefore, the withdrawal of the rejection and the allowance of claims 1-11 is respectfully requested.

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CONCLUSION

For all the above reasons, the Applicant respectfully requests the reconsideration and withdrawal of the rejection and the allowance of claims 1-12.

Respectfully submitted,


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